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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,961	12/01/2000	Isao Tomon	KYO.P0005	5860

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EXAMINER
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O CONNOR, GERALD J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/727,961

Applicant(s)

Tomon

Examiner

O'Connor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on August 8, 2003 (Election)
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above, claim(s) 8-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Dec 1, 2000 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other:  |

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## DETAILED ACTION

### *Election/Restriction*

1. Applicant's election without traverse of the species of Figure 2 in Paper N<sup>o</sup> 6 is hereby acknowledged. Applicant's election indicates that claims 1-8 read on the elected species. However, only claims 1-7 appear to read on the elected species of Figure 2, related to provision of services to users with RFID tags. Claim 8 appears to read on the non-elected species of Figure 14, related to tracking of commercial goods. Therefore, only claims 1-7 will be addressed hereinbelow on the merits. Claim 8 will be withdrawn from further consideration together with the other non-elected claims.
2. Claims 8-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper N<sup>o</sup> 6.

### *Drawings*

3. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).
4. The drawings are objected to because of the various spelling errors therein. For example, "Serual" (2 Pl) in Figure 5, "Costomer" in Figure 10, and "Deteiled" (2 Pl) in Figure 14.

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5. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. No new matter should be entered.

### ***Specification***

6. Applicant is reminded of the proper language and format for an abstract of the disclosure:

The abstract should be in narrative form and generally limited to a *single paragraph* on a separate sheet within the range of 50 to 150 words.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

7. The abstract of the disclosure is objected to for exceeding a single paragraph. Correction is required. See MPEP § 608.01(b).

### ***Claim Objections***

8. Claim 2 is objected to because of the following informalities: it appears that "transmittingmeans" was intended to be --transmitting means-- and that "authenticatingmeans" was intended to be --authenticating means--, which changes will be assumed for purposes of consideration of the claims as to the merits, hereinbelow. Appropriate correction is required.

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***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e)<sup>1</sup> the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

10. Claims 1, 2, and 5-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsumori (US 6,179,206).

Matsumori discloses an IT (Information Technology) system comprising: issuing and managing means 12 for issuing and managing an RFID (Radio Frequency ID) having a unified data format; an S-label on which the issued RFID is recorded; reading means 72 for reading data including said RFID recorded on said S-label; authenticating means for authenticating said RFID

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<sup>1</sup> The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) apply to the examination of this application as the application being examined was (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) as amended by the AIPA (post-AIPA 35 U.S.C. 102(e)).

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read by said reading means; and, service providing means for providing various kinds of services (price check, purchase, etc.) to an owner of said S-label based on data read by said reading means when authentication by said authenticating means achieves success.

Regarding claim 2, the IT system of Matsumori further comprises transmitting means 58 for transmitting, to said authenticating means, said RFID read by said reading means, said issuing and managing means, said transmitting means, said authenticating means, and said service providing means transmitting/receiving data to/from each other through a network.

Regarding claim 5, the S-label of the IT system of Matsumori includes: an RFID storage portion for storing said RFID; a user storage portion for storing data inherent to each S-label; and an electric wave transmission portion for transmitting data stored in said RFID storage portion and said user storage portion by wireless.

Regarding claim 6, the reading means of the IT system of Matsumori is a scanner having a card size (various types of “cards” being available in virtually any size).

Regarding claim 7, the recited functional language (“lending” the S-Label with or without charge for a predetermined period) has been deemed merely intended usage of the invention, hence, afforded little patentable weight. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See MPEP §2114.

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***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumori (US 6,179,206).

Matsumori does not discuss the particular type of link used between the reading means and the transmitting means, thus does not disclose that the link is by means of a USB (Universal Serial Bus) interface or an infrared link, though Matsumori does disclose the use of infrared links elsewhere in the IT system network.

However, the examiner takes Official Notice that both USB interfaces and infrared links are well known, hence, obvious types of means of connecting peripherals to a terminal.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the IT system of Matsumori (if necessary), so as to connect the reading means to the transmitting means by any convenient means, including either a USB interface or an infrared link, as is well known to do, merely as an expedient matter of design choice, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

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***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to the disclosure.

14. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(703) 305-1525**, and whose facsimile number is (703) 746-3976.

The examiner can normally be reached weekdays from 9:30 to 6:00.

Inquiries of a general nature or simply relating to the status of the application should be directed to the receptionist, whose telephone number is (703) 308-1113.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at (703) 308-5183.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306** (fax-back auto-reply receipt service provided). Mailed replies should be addressed to "Commissioner of Patents and Trademarks, Washington, DC 20231." Hand delivered replies should be left with the receptionist on the seventh floor of Crystal Park Five, 2451 Crystal Dr, Arlington, VA 22202.

GJOC  
October 20, 2003

A handwritten signature in black ink, appearing to read "Gerald J. O'Connor", followed by the date "(10-20-03)" in parentheses.

Gerald J. O'Connor  
Patent Examiner  
Group Art Unit 3627